Examiner: John Sipos
Art Unit: 3751
Fax No.: 703-872-9306
Phone No.: 571-272-4468

Docket No.: NHL-HOL-61
Serial No.: 10/666,931
Customer No. 00432

REMARKS

The Office Action dated October 1, 2004, has been reviewed in detail and the application has been amended in the sincere effort to place the same in condition for allowance. Reconsideration of the application and allowance in its amended form are requested based on the following remarks.

Applicants retain the right to pursue broader claims under 35 U.S.C. §120.

Applicants have provided a unique solution with respect to problems regarding A BEVERAGE BOTTLING PLANT FOR FILLING BOTTLES WITH A LIQUID BEVERAGE FILLING MATERIAL AND A LABELLING STATION FOR LABELLING FILLED BOTTLES AND OTHER CONTAINERS. Applicants' solution is now claimed in a manner that satisfies the requirements of 35 U.S.C. §102, 103, and 112.

Telephonic Interview:

The undersigned would like to sincerely thank the Examiner for the courtesies extended during a telephonic interview between the Examiner and the undersigned on January 19, 2005. During the telephonic interview, the applied prior art references were primarily discussed. At that time distinctions of the present invention were

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pointed out by the undersigned and proposals were subsequently made by the undersigned for limitations that could be added to the independent claims so as to more fully distinguish the present invention over the applied prior art. The undersigned argued that the applied prior art did not show high-speed labeling systems and mechanisms, specifically those labeling systems and mechanisms that utilize pie-piece-shaped elements to grip and transfer individual labels at a substantially higher speed than those that utilize only drums, cylinders, or similar structures.

An agreement was not reached between the Examiner and the undersigned as to a limitation that could be added to the independent claims so as to render the independent claims allowable over the applied prior art. However, the Examiner indicated that he would carefully consider the undersigned's arguments and any amendments to the claims in support of such arguments. Claims 1-4 have therefore been amended accordingly, and new Claims 37-52 have been submitted.

The Examiner also mentioned that one of the cited - but not applied - references was Zodrow (U.S. 4,079,875). The Examiner pointed out that Zodrow showed pie-piece-shaped elements, and

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therefore such a reference would most likely be used in combination with the presently applied prior art references in a rejection under 35 U.S.C. §103. In anticipation of such a rejection, arguments are presented below with respect to Zodrow in combination with any one of the four applied prior art references.

The telephonic interview is further summarized below in the section entitled "Recordation of the Substance of the Telephonic Interview."

Rejection of Claims 4-20 Under 35 U.S.C. §102:

Claims 4-20 were rejected under 35 U.S.C. §102, as being unpatentable over Kontz (U.S. 2,621,823) or Perry (U.S. 4,724,029). In addition, Claims 4-9 and 13-18 were rejected under 35 U.S.C. §102, as being unpatentable over Voltmer (U.S. 4,605,459) or Von Hofe (U.S. 2,524,945). Claims 5-20 have been canceled, without prejudice, thereby rendering the present rejection against these claims moot. However, new Claims 37-52 will be discussed herein with respect to the applied references.

Kontz, as understood, shows a labeling device in which a supply of labels on a continuous roll R is fed to a vacuum drum 5. Individual labels L are cut from the web W of labels and held by the vacuum force on the periphery 12 of the drum 5. Meanwhile, a

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starwheel structure 50 with asymmetrical starwheel pockets advances containers in a spaced apart manner into a guide structure 54 that guides the containers past the vacuum drum 5 to receive labels. Each of the labels is heated by a warm air distributor 15 which applies warm air to the labels to heat the adhesive on the back of labels, which adhesive attaches the labels to the containers.

Perry, as understood, shows a labeling machine in which individual labels are removed from a stack of labels C and placed on an activating and applying drum D. The drum D is heated in order to heat the labels and render the adhesive thereon tacky. The labels are then transferred from the drum D to containers 20 moving past the drum D on a linear conveyor 24.

Voltmer, as understood, shows a system for securing literature to containers. Segments 17 of a continuous roll 10 of adhesive band material are picked up by individual applicators and heated to activate the adhesive. Literature packets 19 are attached to the adhesive segments 17, and then applied to containers 20, 20', thereby attaching the literature 19 to the containers 20, 20'.

Von Hofe, as understood, shows a labeling mechanism that uses a belt system 14 to transport labels 26 from a continuous roll 24 of labels to containers. The labels 26 are heated by heating means 20

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to activate the adhesive.

In contrast to each of Kontz, Perry, Voltmer, and Von Hofe, amended Claim 4 recites: "said at least one label gripper being substantially in the shape of a pie piece." Both Kontz and Perry show drums for gripping the labels. Voltmer shows individual label applicators, but they are not substantially in the shape of a pie piece. Von Hofe shows an endless belt for gripping the labels. Claim 4 is therefore believed to distinguish over and not be rendered obvious by any one of Kontz, Perry, Voltmer, or Von Hofe. Claims 37-43 are also believed to distinguish over and not be rendered obvious by any one of Kontz, Perry, Voltmer, or Von Hofe based on their dependence from Claim 4 and the features recited therein.

Also in contrast to each of Kontz, Perry, Voltmer, and Von Hofe, Claim 44 recites: "gripping a label with said at least one pie-piece-shaped label gripper" and "releasing a gripped label from said at least one pie-piece-shaped label gripper to thus permit a label to be applied to a container." Both Kontz and Perry show drums for gripping the labels. Voltmer shows individual label applicators, but they are not substantially in the shape of a pie piece. Von Hofe shows an endless belt for gripping the labels. Claim 44 is therefore believed to distinguish over and not be rendered obvious by any one

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of Kontz, Perry, Voltmer, or Von Hofe. Claims 45-52 are also believed to distinguish over and not be rendered obvious by any one of Kontz, Perry, Voltmer, or Von Hofe based on their dependence from Claim 44 and the features recited therein.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

Rejection of Claims 1-3, 16, 17, 19, and 20 Under 35 U.S.C. §103:

Claims 1-3, 16, 17, 19, and 20 were rejected under 35 U.S.C. §103 as being unpatentable over Kontz, Perry, Voltmer, or Von Hofe. These references are discussed above.

Claims 16, 17, 19, and 20 have been canceled herein, without prejudice, rendering the present rejection against these claims moot.

In contrast to each of Kontz, Perry, Voltmer, and Von Hofe, amended Claim 1 recites: "each of said label grippers being substantially in the shape of a pie piece." As discussed above, none of the applied references teaches or suggests substantially pie-piece-shaped label grippers. Claim 1 is therefore believed to distinguish over and not be rendered obvious by any one of Kontz, Perry, Voltmer, or Von Hofe, either taken singly or in any reasonable combination thereof. Claims 2 and 3 are also believed to distinguish over and not be rendered obvious by any one of Kontz, Perry,

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Voltmer, or Von Hofe based on their dependence from Claim 1 and the features recited therein.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

Rejection of the claims in view of Zodrow:

During the interview, the Examiner indicated that Zodrow showed a labeling mechanism that utilized pie-piece-shaped elements to transfer labels. The Examiner stated that such a reference would therefore most likely be applied in combination with any one of the presently applied prior art references under 35 U.S.C. §103 to reject claims that were amended to recite pie-piece-shaped label grippers.

In that regard, it should be noted that MPEP 2142 states the following regarding the obviousness of combining two or more references:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of these criteria, it is respectfully submitted that a rejection

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based on the possible combination of Zodrow and any one of Kontz, Perry, Voltmer, or Von Hofe would be improper. First, there is no suggestion or motivation described in Zodrow or any of the other four references to incorporate the pie-piece-shaped elements of Zodrow into the labeling systems of the other references. Since such a suggestion or motivation is the first criteria for establishing a *prima facie* case of obviousness, such a rejection would be improper. In this regard, it is important to note the decision of the Court of Appeals, Federal Circuit (CAFC) in its opinion in In re Howard Sernaker, 702 F. 2d 989, wherein, a Patent and Trademark Board of Appeal affirmance of an Examiner's rejection under 35 U.S.C. §103, based on a combination of references, was overturned.

In Sernaker, the invention involved related to a method for producing embroidered "emblems" which closely resembled emblems of the prior art embroidered with different colored thread. In the claims on appeal, a sculptured embroidery was produced from a single colored thread (e.g., white); a heat-transferable transfer print (e.g., a decal) was provided; the sculptured embroidery and the transfer print were mated and aligned; and color was transferred from the print to the embroidery by the application of heat.

Sculptured one-color embroideries were known in the prior art,

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as was the heat transferable printing process. However, the CAFC held the claims on appeal nonobvious, stating the relevant tests to be:

> "(a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and
>
> (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable combination."

The CAFC recognized that the separate elements of the white sculptured embroidery and the heat-transferable dyeing process existed in the prior art. However, they pointed to the absence, in the references themselves or in the prior art general knowledge as a whole, of any recognition or suggestion that further improvements could be achieved by combining these known elements in the manner taught and claimed in the application (e.g., in a mated and aligned fashion). It is believed that the decision of Sernaker is applicable in the present application, as there is nothing in the two references which teaches or suggests that the references be combined.

Further, since there is nothing in the references to teach that they be combined, it is also submitted that the only motivation to combine the references would be the present disclosure itself, and such hindsight analysis of the available art is considered improper.

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In In re Deminski, 230 USPQ 313 (1986), the CAFC overturned a decision of the Board of Patent Appeals and Interferences regarding obviousness of the invention in view of prior references. In Deminski, the Board upheld the Examiner's rejection of Claims 17, 18 and 21 in view of obviousness over the prior art. These claims have the limitation that the valve sets in the valve chambers be connected to permit withdrawal as a unit. The Board argued that if the Pocock reference would have attached the valve stem to the valve structure, the valve assembly would have been removable as a unit. The CAFC found nothing in the references to "suggest the desirability, and thus the obviousness" of designing the valve assembly to be removable, and stated that "the only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether the subject matter as a whole would have been obvious at the time the invention was made." In view of the above decision in In re Deminski, it is submitted that, only upon a reading of the specification of the present application that one would possibly be motivated to provide the labeling systems of the four presently-applied references with the pie-piece-shaped elements of Zodrow.

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In addition, to establish a *prima facie* case of obviousness there also must be a reasonable expectation of success. It is respectfully submitted that one could not reasonably expect a successful outcome by simply swapping the pie-piece-shaped elements of Zodrow for the drums, applicators, and belts of the four applied prior art references.

To further explain, it should be understood that such pie-piece-shaped elements are used in labeling systems that operate at much higher speeds than those that utilize only drums or cylinders. This is because the pie-piece-shaped elements, because of their smaller size, together have a smaller total mass and weight than a drum or cylinder. This smaller mass allows the pie-piece-shaped elements to be moved at about twice the speed of a drum or cylinder. Although this may not sound like much of an increase in speed, it makes a huge difference in production of labeled bottles because, for example, output could be increased from 15,000 bottles an hour to 30,000 bottles an hour if the speed is doubled. Consequently, the overall cost of labeling bottles or containers would be substantially reduced.

At such high speeds, all of the components of the labeling system, and for that matter the bottling system as a whole, must be carefully sized and calibrated to operate together smoothly and efficiently. One could not simply swap parts and mechanisms in and

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out without carefully considering the effect such changes would have on the system as a whole. The labeling systems of Kontz, Perry, Voltmer, or Von Hofe would have to undergo substantial or even drastic modifications in order to successfully incorporate the pie-piece-shaped elements of Zodrow. In addition, there is nothing to suggest that the heating systems of Kontz, Perry, Voltmer, or Von Hofe would work in a high speed labeling system with pie-piece-shaped label grippers, such as defined in the claims herein. For these reasons it is believed that such a combination does not satisfy the second criteria for establishing a *prima facie* case of obviousness.

In view of the above, it is respectfully submitted that the claims as amended and presented herein would distinguish over and not be rendered obvious by Zodrow in view of any one of Kontz, Perry, Voltmer, or Von Hofe.

Rejection of Claims 2 and 3 Under 35 U.S.C. §112, First Paragraph:

Claims 2 and 3 were rejected for the reasons set forth on pages 3 and 4 of the outstanding Office Action. Claims 2 and 3 have been amended herein in a manner believed to overcome the Examiner's rejection.

Rejection of Claims 2, 3, 8-12, and 18-20 Under 35 U.S.C. §112,

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Second Paragraph:

Claims 2, 3, 8-12, and 18-20 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention for the reasons set forth on pages 3 and 4 of the outstanding Office Action. Claims 2 and 3 have been amended herein in a manner believed to overcome the Examiner's rejection. Claims 8-12 and 18-20 have been canceled herein, without prejudice, and new Claims 21-36 have been drafted in a manner believed to overcome the Examiner's rejection relating to those claims.

Objection to the Specification:

The specification was objected to as not providing disclosure for the "apparatus...to press and smooth a label to a bottle" recited in Claims 1-3. This feature has been deleted from the claims, thereby rendering the objection to the specification moot.

The Examiner also required that an abstract of the disclosure be submitted on a separate sheet. An abstract was therefore submitted with the Amendment filed March 1, 2005.

Objection to the Drawings:

The drawings were objected to under 37 CFR 1.83(a) as not showing every feature specified in the claims. Specifically, the

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Examiner stated that the drawings do not show the heating mechanisms as claimed in subparagraph (A) of Claim 2 and elsewhere in the claims, and the cooling mechanism of the last paragraph of Claim 2 and elsewhere in the claims.

It is respectfully submitted that these claimed features are shown in the drawings. The heating mechanisms of Claim 2 are possible embodiments of the heating apparatus. The heating apparatus 4 is shown in each of Figures 1, 1B, 2, and 2A. Since the heating apparatus encompasses the heating mechanisms recited in Claim 2 and elsewhere, it is respectfully submitted that the heating mechanisms are representatively shown in the drawings.

It is also respectfully submitted that the cooling mechanism is shown in the drawings. Specifically, Figure 1B shows a mechanism 20 which is a heating or cooling mechanism.

In view of the above, reconsideration and withdrawal of the present objection is respectfully requested.

Recordation of the Substance of the Telephonic Interview:

In order to render this Amendment complete, the following is a recordation of the substance of the telephonic interview conducted with the Examiner on January 19, 2005:

1) No exhibits were shown, nor were any demonstrations

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conducted.

2) Primarily, independent Claim 1 was discussed.

3) Primarily, the prior art discussed was Kontz (U.S. 2,621,823), Perry (U.S. 4,724,029), Voltmer (U.S. 4,605,459), Von Hofe (U.S. 2,524,945), and Zodrow (U.S. 4,079,875).

4) Applicant's representative essentially proposed to amend the independent claims in the manner set forth in this Amendment.

5) Generally, Applicant's representative submitted, inter alia, that the prior art discussed did not teach nor suggest pie-piece-shaped label grippers as part of a high-speed labeling system.

6) Generally no other pertinent matters were discussed.

7) The general outcome of the interview was an agreement between the Examiner and the Applicant's representative that the Examiner would carefully consider arguments and amendments to the claims in accordance with the arguments presented by the Applicant's representative in the interview.

Art Made of Record:

The prior art made of record and not applied has been carefully reviewed, and it is submitted that it does not, either taken singly or in any reasonable combination with the other prior art of record, defeat the patentability of the present invention or render the present

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invention obvious. Further, Applicants are in agreement with the Examiner that the prior art made of record and not applied does not appear to be material to the patentability of the claims currently pending in this application.

Leave to Delay Treatment of Formal Objections Until Allowable Subject Matter is Indicated:

In accordance with 37 C.F.R. §1.111, it is hereby respectfully requested that any objections or requirements not fully treated and set forth in the outstanding Office action that relate to form and are not necessary to further consideration of the now pending claims, be held in abeyance until allowable subject matter is indicated.

Summary and Conclusion:

It is submitted that Applicants have provided a new and unique BEVERAGE BOTTLING PLANT FOR FILLING BOTTLES WITH A LIQUID BEVERAGE FILLING MATERIAL AND A LABELLING STATION FOR LABELLING FILLED BOTTLES AND OTHER CONTAINERS. It is submitted that the claims, as amended, are fully distinguishable from the prior art. Therefore, it is requested that a Notice of Allowance be issued at an early date.

If mailed, I, the person signing this certification below, hereby certify that this correspondence is being deposited with the United

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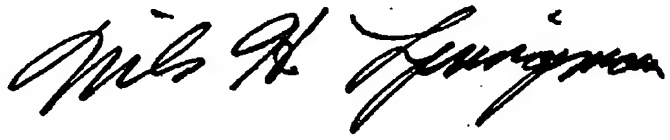
States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date indicated in the certification of mailing on the transmittal letter sent herewith, or if facsimile transmitted, I, the person signing this certification below, hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated in the certification of facsimile transmission on the transmittal letter which is being facsimile transmitted herewith.

Respectfully submitted,



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